



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/766,860

01/30/2004

Mikako Ochiai

1046.1308

5313

21171 7590 03/04/2009  
STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

COULTER, KENNETH R

ART UNIT

PAPER NUMBER

2441

MAIL DATE

DELIVERY MODE

03/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/766,860	<b>Applicant(s)</b> OCHIAI, MIKAKO	
	<b>Examiner</b> Kenneth R. Coulter	<b>Art Unit</b> 2441	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 32, 37, and 46 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend upon a multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 32, 37, and 46 have not been further treated on the merits.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2441

Claims 1, 3, 7, 9, 10, 13, 15, 17, 19, 23, 24, 26, 29, 31, 33, 35, 39, 41, 42, 45, and 47 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, and 4 of copending Application No. 11/102,790. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the mapping below.

Claim 1 of the present Application maps to claims 1, 3, 4 (combined) of '790.

Claim 3 of the present Application maps to claims 1, 3, 4 (combined) of '790.

Independent claims 7, 9, 10, 13, 15, 17, 19, 23, 24, 26, 29, 31, 33, 35, 39, 41, 42, 45, and 47 map similarly.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 31, 33 – 36, 38 – 45, 47, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Marsh et al. (U.S. Pat. No. 6,763,462) (E-Mail Virus Detection Utility).

1.1 Regarding claim 1, Marsh discloses an abnormality detection method on a server, by which the server for providing an electronic mail transmission service via a network to a computer making a request for transmitting an electronic mail detects an operational abnormality of the computer, the method comprising:

- a step of accepting the electronic mail transmission request from the computer (Figs. 1, 2; Abstract; col. 2, lines 12 – 33; col. 3, lines 11 – 34);

- a step of transmitting the electronic mail of which the transmission request has been accepted (Figs. 1, 2; col. 2, lines 12 – 33; col. 3, lines 11 – 34);

- a step of accumulating transmission history information about the transmitted electronic mail (Fig. 2; col. 3, lines 11 – 34 “virus detection utility 104 may examine e-mail distribution patterns by **comparing** selected **e-mail addresses** corresponding to the random numbers with **potential recipients of the outgoing e-mail message** at block 204”);

- a step of referring to request history information about a transmission request history of the electronic mail that is accumulated on the computer (Abstract; Fig. 2; col. 3, lines 11 – 34);

- a step of comparing the transmission history information with the request history information (Fig. 2; col. 3, lines 11 – 34); and

a step of detecting the operational abnormality of the computer on the basis of a result of the comparison (Fig. 2; col. 3, lines 11 – 34).

1.2 Per claim 2, Marsh teaches an abnormality detection method on a server according to claim 1, further comprising:

a step of referring to a transmission confirming condition on the computer when transmitting the electronic mail (Fig. 2; col. 2, lines 12 – 33; col. 3, lines 11 – 34);

a step of confirming the transmission history information containing the latest transmitted electronic mail in accordance with the transmission confirming condition (Fig. 2; col. 3, lines 11 – 34); and

a step of referring to, in case the result of the confirmation in the confirming step meets a predetermined standard, the request history information and comparing the request history information with the transmission history information (Fig. 2; col. 3, lines 11 – 34).

1.3 Regarding claim 3, the rejection of claim 1 under 35 USC 102(e) (paragraph 1.1 above) applies fully.

1.4 Per claim 4, Marsh teaches an abnormality detection method on a server according to claim 1 or 3, further comprising a step of informing the computer that the operational abnormality of the computer has been detected (Fig. 2, item 208; col. 3, lines 35 – 43 “A user may be notified of possible virus activity”).

1.5 Regarding claim 5, Marsh discloses an abnormality detection method on a server according to any one of claims 1-3, further comprising:

a step of referring to the operation history information of mail software for making a request for transmitting the mail on the computer (Fig. 2; col. 3, lines 11 – 34);

a step of comparing the operation history information with the transmission history information (Fig. 2; col. 3, lines 11 – 34); and

a step of detecting the operational abnormality of the computer when a content of the transmission history information is in a predetermined relationship with a content of the operation history information (Fig. 2; col. 3, lines 11 – 34).

1.6 Per claim 6, Marsh teaches an abnormality detection method on a server according to any one of claims 1-3, wherein the server is a relay device for relaying the electronic mail to a transmitting destination (col. 3, line 66 – col. 4, line 21).

1.7 Regarding claims 7 – 31, 33 – 36, 38 – 45, 47, and 48, the rejection of claims 1 – 6 under 35 USC 102(e) (paragraphs 1.1 – 1.6 above) applies fully.

Claims 1 – 31, 33 – 36, 38 – 45, 47, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Yasaki (U.S. Pat. Pub. No. 2005/0182970) (Electronic Mail Apparatus, Electronic Mail System, and Electronic Mail Transmission Method)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

2.1 Regarding claim 1, Yasaki discloses an abnormality detection method on a server, by which the server for providing an electronic mail transmission service via a network to a computer making a request for transmitting an electronic mail detects an operational abnormality of the computer, the method comprising:

- a step of accepting the electronic mail transmission request from the computer (Abstract; Fig. 4; paragraphs 14, 23);

- a step of transmitting the electronic mail of which the transmission request has been accepted (Fig. 4; paragraphs 14, 23);

- a step of accumulating transmission history information about the transmitted electronic mail (paragraphs 23, 64, 84);

- a step of referring to request history information about a transmission request history of the electronic mail that is accumulated on the computer (Fig. 4; paragraphs 14, 23, 64, 84);

- a step of comparing the transmission history information with the request history information (Fig. 4; paragraphs 84, 64, 23); and



a step of detecting the operational abnormality of the computer on the basis of a result of the comparison (Fig. 4; paragraphs 84, 64, 23).

2.2 Per claim 2, Yasaki teaches an abnormality detection method on a server according to claim 1, further comprising:

a step of referring to a transmission confirming condition on the computer when transmitting the electronic mail (Figs. 4, 6; paragraphs 23, 64, 84);

a step of confirming the transmission history information containing the latest transmitted electronic mail in accordance with the transmission confirming condition (paragraphs 23, 64, 84); and

a step of referring to, in case the result of the confirmation in the confirming step meets a predetermined standard, the request history information and comparing the request history information with the transmission history information (Figs. 4, 6; paragraphs 23, 64, 84).

2.3 Regarding claim 3, the rejection of claim 1 under 35 USC 102(e) (paragraph 2.1 above) applies fully.

2.4 Per claim 4, Yasaki teaches an abnormality detection method on a server according to claim 1 or 3, further comprising a step of informing the computer that the operational abnormality of the computer has been detected (paragraphs 18, 55).

Art Unit: 2441

2.5 Regarding claim 5, Yasaki discloses an abnormality detection method on a server according to any one of claims 1-3, further comprising:

a step of referring to the operation history information of mail software for making a request for transmitting the mail on the computer (paragraphs 23, 64, 84);

a step of comparing the operation history information with the transmission history information (Figs. 4, 6; paragraphs 23, 64, 84); and

a step of detecting the operational abnormality of the computer when a content of the transmission history information is in a predetermined relationship with a content of the operation history information (paragraphs 23, 64, 84).

2.6 Per claim 6, Yasaki teaches an abnormality detection method on a server according to any one of claims 1-3, wherein the server is a relay device for relaying the electronic mail to a transmitting destination (Figs. 7, 10; paragraphs 97, 117).

2.7 Regarding claims 7 – 31, 33 – 36, 38 – 45, 47, and 48, the rejection of claims 1 – 6 under 35 USC 102(e) (paragraphs 2.1 – 2.6 above) applies fully.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2441

Chemali      U.S. Pat. Pub. No. 2003/0055951      Products, Apparatus and  
Methods for Handling Computer Software/Hardware Messages

An email handling device that monitors messaging for “any messaging parameter or statistic, which appears out of the ordinary (when compared to the expected or historical data)” (paragraph 71).

Maher et al.      U.S. Pat. No. 6,910,134      Method and Device for  
Innoculating Email Infected With a Virus

Method that compares email packets with known virus signatures in order to detect an email infected with a virus.

Sasage et al.      U.S. Pat. Pub. No. 2002/0104024      Method for  
Detecting and Managing Computer Viruses in System for Sending or Receiving  
Electronic Mail (Fujitsu)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2441

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/  
Primary Examiner, Art Unit 2441

/KRC/